

REMARKS

Please reconsider the present application in view of the following remarks. Applicant thanks the Examiner for carefully considering the present application.

I. Disposition of the Claims

Claims 1-20 were originally filed with the present application. A Preliminary Amendment, filed together with the present application, canceled claims 1-51 and added claims 52-71.¹ In response to the Restriction Requirement of June 20, 2005, claims 59-65 were elected with traverse. By way of this reply, claims 52-58 and 66-71 have been withdrawn, and claims 72-78 have been added. Accordingly, claims 59-65 and 72-78 are currently pending.

II. New Claims

New claims 72-78 have been added, of which claim 72 is independent with claims 73-78 depending therefrom. Claims 72-78 are directed to a call management system that at least in one respect is arranged to perform the acts recited in previously presented claims 59-65. No new matter has been added by new claims 72-78. Further, for at least similar reasons set forth below with respect to claims 59-65, new claims 72-78 are allowable over the cited prior art.

Accordingly, entry and favorable treatment of new claims 72-78 is respectfully requested.

III. Rejection(s) under 35 U.S.C. § 103

Claims 59-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,535,261 ("Brown") in view of U.S. Patent No. 5,539,812 ("Kitchin"). For the

¹ As indicated previously, the Preliminary Amendment was intended to cancel claims 1-20 and add claims 21-40. The claims have not yet been renumbered.

reasons set forth below, these rejections are respectfully traversed.

In order to establish a *prima facie* case of obviousness, the Examiner must show (i) some suggestion or motivation, either in the references themselves or based on knowledge of one of ordinary skill in the art, to modify the reference or to combine reference teachings, (ii) a reasonable expectation of success, and (iii) that the references when combined teach or suggest all the claim limitations. *See* MPEP § 2143. As shown below, the Examiner has failed to meet this burden.

Independent claim 59 requires in part *executing call-bridging prevention instructions* in response to an identified call-bridging attempt *based upon comparing the tones* to the predetermined call-bridging tone set. Both Brown and Kitchin fail at least to disclose this limitation.

In regard to Brown, the Office Action specifically states that Brown fails to disclose preventing a 3-way call. Thus, Brown necessarily fails to disclose executing call-bridging prevention instructions based on comparing tones as required by independent claim 59.

As to Kitchin, Kitchin discloses a system capable of detecting whether either of the parties to a telecommunication between a local telephone and a remote telephone has attempted to initiate a three-way call using a hook-flash signal. *See* Kitchin, Abstract. The system of Kitchin detects the hook-flash signal by detecting an energy pulse of the hook-flash signal. *See, e.g.,* Kitchin, column 3, lines 19-62 (disclosing using digital signal processor (DSP) circuitry to detect and analyze received energy levels); Kitchin, Figure 2.

Kitchin's detection of pulse energy levels is distinct from detecting tones. Those skilled in the art will recognize that pulse dialing involves pulses generated as a result of rapidly disconnecting and connecting the calling party's phone line, whereas tone dialing relies on

generating recognizable sound tones over the phone line. Further, as described in the Specification, the ability to detect tones is advantageous as it allows for a wide range of opportunities to detect/prevent three-way calls. *See, e.g.*, Specification, page 13, line 7 – page 14, line 5. Kitchin, while disclosing means for detecting hook-flash signal generated pulses, is completely silent as to the detection of tones. Accordingly, Kitchin, like Brown, fails to disclose *executing call-bridging prevention instructions* in response to an identified call-bridging attempt *based upon comparing the tones* to the predetermined call-bridging tone set as required by independent claim 59.

Further, there is no motivation or suggestion to combine the teachings of Brown and Kitchin. In fact, the Office Action is completely silent as to any reason why one skilled in the art would combine Brown and Kitchin. Such omission by itself results in the failure to establish a *prima facie* case of obviousness. Applicant notes nonetheless that while Brown, the primary reference, discloses automatically recording a phone call in response to a specific event, such as an attempt to make a three-way call, Brown does not in any way contemplate how this type of event is to be detected or suggest any problem in doing so. The mere fact that Brown and Kitchin may be technically combined or modified does not render the resultant combination obvious; Brown and Kitchin must suggest *the desirability* of the combination. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. Thus, as Brown fails to suggest any reason to one skilled in the art to turn to the teachings of Kitchin, Brown and Kitchin are not properly combinable. Similarly, one presented with Kitchin's description of a way to detect three-way calls via pulse energy detection would have no reason to turn to Brown, which is directed to automatically recording phone calls.

In view of the above, Brown and Kitchin, whether taken singly or in combination, fail to

disclose the invention recited in independent claim 59. Further, Brown and Kitchin are not combinable under § 103. Thus, independent claim 59 is patentable over Brown and Kitchin. Dependent claims 60-65 are allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

IV. Conclusion

The Examiner is encouraged to contact the undersigned attorney if it would be beneficial to further advance the prosecution of the application.

Please apply any charges not covered, or any credits, to Deposit Account 19-2555 (Reference No. 18279-08041).

Respectfully Submitted,
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Date:

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